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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/690,773 | 10/17/2000 | Geoffrey B. Rhoads | 60310 | 3646 |

23735 7590 08/13/2003

DIGIMARC CORPORATION
19801 SW 72ND AVENUE
SUITE 100
TUALATIN, OR 97062

EXAMINER

HAILU, TADESSE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2173

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

4

Office Action Summary

Application No.

09/690,773

Applicant(s)

RHOADS ET AL.

Examiner

Tadesse Hailu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-16 is/are rejected.
- 7) ☒ Claim(s) 4 and 17-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This Office Action is in response to the patent application (09/427,680) filed on 10/27/1999.

Priority

2. The present patent application claims priority from domestic US Application 60/134,782 filed 19 May 1999.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "the gave" in line two of the claim is indefinite. Claim 20 also rejected for reciting the limitation "the gave" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of

paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-3, 5-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads (6,553,129).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The present invention provides methods and systems for associating watermark-enabled objects with machine behaviors. Likewise, Rhoads ('129) also provides hot linked image object (e.g. with embedded URLs) when clicked (or triggered) the linked image object will be associated with the object's predefined actions.

With regard to claim 1, ('129) discloses a system for enabling a user to associate an computer task with an object. The system includes a registry, wherein the registry is accessible

via a telecommunications network to enable users to provide an association between a code and information about an electronic object in which the code is to be steganographically embedded (see ('129): claims 29 and 32). The registry is a server on the Internet, accessible via the World Wide Web, coupled to a database. The database includes detailed information on catalogued images (e.g. name, address, phone number of proprietor, and a schedule of charges for different types of uses to which the image may be put), indexed by identification codes with which the images themselves are encoded. A person who decodes an image queries the registry with the codes thereby gleaned to obtain the desired data. (Column 102, lines 10-26).

With regard to claim 2, as described in the rejection of claim 1, ('129) describes that the registry is accessible via a telecommunications network to enable users to provide an association between a code and information about an electronic object in which the code is to be steganographically embedded (see ('129): claims 29 and 32).

With regard to claim 3, ('129) also describes that the object id includes a watermark id, which are embedded in watermarks on the corresponding objects (see ('129): claims 1, 5 and 11).

With regard to claims 5, and 8, ('129) describes that the digital electrical computer system is enabled to load a World Wide Web browser and connect to the World Wide Web site in response to the revealed one of the plurality of creator identifiers (see ('129): claim 16).

With regard to claim 6, ('129) discloses a GUI (such as Fig. 48) that enables a user to view an image of an object along with an image of a computer task to be associated with the object, the GUI also includes a dialog box (control) that enables user to associate the object with

the behavior, and the GUI is operable to communicate a database (see ('129): figs. 48-52, also see claim 29).

With regard to claim 7, ('129) describes that the object identifier is embedded into the object using a watermark (see ('129): claims 23, and 26).

With regard to claim 9, FIG. 52 of ('129) shows a screen that is being produced in response to the reading a watermark. This screen provides the Creator ID of the owner and/or distributor of this image, as well as whether use of this image is restricted or royalty free. Note the Web Lookup button, which can be selected to launch a WWW browser directed by the URL address shown entered on the screen to the MarcCentre Web Page, and obtains the data in the corresponding MarcCentre database corresponding to the Creator ID (see description of Fig. 52).

With regard to claim 10, ('129) provides a user GUI to edit or specify an object and a task to be associated with the object (see ('129): claim 3). ('129) also describes receiving specification or data of an object and a task to be associated with the object (see ('129): claims 3, and 12). ('129) further describes editing (updating) a database, wherein the database is operable to launch the task in response to receiving an object id decoded from machine readable code on the object (see ('129): claims 3, and 12).

With regard to claims 11, and 12, ('129) discloses means by which a user with a Creator ID embeds a registered watermark in step 2 of FIG. 43 is elaborated in FIGS. 47, 48, and 49.

With regard to claims 13, and 14, ('129) further describes that After the Creator ID is entered, selection of the Register option launches a WWW browser directed by the URL

address shown entered on the screen to the MarcCentre registration page (see ('129): fig. 48-52).

With regard to claim 15, this claim corresponds generally to independent claim 10 and recites similar features in a computer readable medium form (storage medium) form, and therefore is rejected under the same rationale.

With regard to claim 16, as described in the rejection of claim 1, a task process is launched in response to decoding the watermark in the object (see ('129): column 102, lines 10-26, claim 1).

Allowable Subject Matter

5. Claims 4, 17-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: while ('129) describes watermarked electronic object, but ('129) fails to describe that the object as being a watermarked sticker (claims 4, and 17), a prop (claims 18 and 20), and the watermarked electronic object having two or more facets (claim 19). ('129) further fails to describe the machine behavior (task) to include launching an e-mail program that is directed to a destination associated with the object via the watermark (claim 21), the machine behavior (task) to include launching an Internet chat session, and the machine behavior (task) to include placing a telephone call to a destination associated with the object (claim 23).

Thus, for at least the reasons provided above, Rhoads (6, 553,129) does not anticipate the above claims under 35 USC 102(e).

Art Unit: 2173

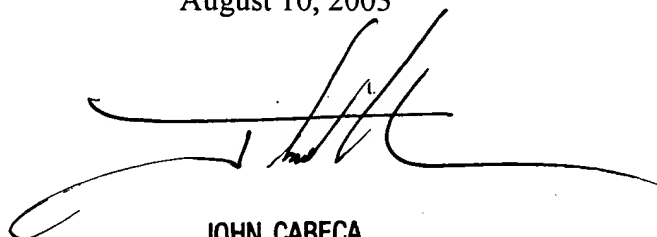
Conclusion

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (703) 306-2799. The Examiner can normally be reached on M-F from 10:00 - 8:30 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (703) 308-3116 Art Unit 2173.

8. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Tadesse Hailu

August 10, 2003

A handwritten signature in black ink, appearing to read 'John Cabeca', with a long horizontal flourish extending to the right.

JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2